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EXAMINER

JEANTY, ROMAIN

ART UNIT PAPER NUMBER

3623

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,249

Applicant(s)

ALSAFADI, YASSER

Examiner

Romain Jeanty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Final Office action is in response to the amendment filed September 12, 2005. In the amendment, claims 1-22 have been amended. Claims 1-22 are pending in the application.

Response to Arguments

2. Applicant's arguments with respect to claims 1-22 have been considered but are found to be non-persuasive.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the limitation of “retrieving the optically encoded information”, is not supported by the specification. The examiner is unable to find where such limitation is

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disclosed in the specification. Therefore, one skilled in the art would not know how to make and/or use the invention.

Claims 2-11 and 13-22 depend from claims 1 and 12; therefore claims 2-11 and 13-22 are rejected under 35 U.S.C. 112 first rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8, 11-19, 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first

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test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in

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affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, method claim 1 is in the technological art (i.e, electronically storing the physical object...), however, claim 1 fails to produce a useful, concrete and tangible result (i.e. creating the profile of the of the person).

From this it can be seen that the broadest reasonable equivalent disclosed fails to recite a concrete and tangible result test and therefore recites non-statutory subject matter under 35 USC 101.

Claims 2-8 depend from independent claim 1; therefore claims 2-8 are rejected under the same rationale relied upon of claims 1 and 12.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7, 9-18, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Headrick et al (Hereinafter referred to Headrick) (U.S Patent 6,535,889) in view of Hertz et al (Hereinafter referred to Headrick, U.S. Patent No. 6,571,279).

As per claims 1, 4-7, and 10, Headrick discloses a method for associating a unique identification tag with an object. In so doing, Headrick discloses identifying at least one object associated with the person (col. 10, lines 53-56);

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retrieving information related to the object or icon via a tag (col. 4, lines 7-11);

electronically accessing an object profile in accordance with the information received from the tag, and *electronically* accessing a unique profile associated with the person (i.e. retrieving the user's profile, col. 12 line 62 through col. 13 line 16).

Headrick discloses all of the limitations above except for modifying the unique profile in accordance with the object profile. Hertz in the same field of endeavor, discloses the concept of modifying a user's profile (col. 18 lines 34-55). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the disclosures of Headrick to include the teachings of Hertz with the motivation to automatically determine the profile of the user.

Applicant has amended the claims to recite retrieving said optically encoded and/or electronically stored information. It is noted that Headrick does teach such step of retrieving. Note rejection above.

As per claims 2-3, Headrick does not explicitly disclose the steps of receiving a key to facilitate accessing the unique profile, and wherein the key is credit card number, a social security number, a voice print, a vehicle identification number (VIN) or a unique random number. However, Hertz discloses the concept of providing a private key to provide access to the user's profile information (col. 20, lines 35-47). It would have been obvious to a person of ordinary skill in the art to use a key or is credit card number, a social security number, a voice print, a vehicle identification number (VIN) or a unique random number in the disclosures of Hertz because it would provide security in the systems of Headrick and Hertz with regard to the user's profile information.

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As per claim 9, Hertz further discloses the method according to claim 1, wherein the object profile and the unique profile comprise XML documents (col. 21, lines 8-23).

As per claim 10, Hertz further discloses wherein the object profile and the unique profile are stored in one or more databases that are accessed via a communication network (col. 4, lines 35-48).

As per claim 11, Hertz teaches the tag comprises barcode tag (col. 26 line 63 through col. 27 line 35).

Claims 12-18, 20-22 are memory medium including code for creating a profile related to a person, for performing the steps of method claims 1-7, and 9-11; and therefore claims 12-18, and 20-22 are rejected under the same rationale relied upon claims 1-7, 9-11.

8. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Headrick et al (Hereinafter referred to Headrick) (U.S. Patent 6,535,889) in view of Hertz et al (Hereinafter referred to Headrick, U.S. Patent No. 6,571,279) and further in view of Maloney (U.S. Patent No. 6,407,665).

As per claims 8 and 19, the combination of Headrick and Hertz fails to disclose a tag is integrated, embedded, coupled or temperately associated with the object. Moloney in the same field of endeavor discloses the concept of a tag being integrated (col. 13, lines 33-44). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the disclosures of Headrick and Hertz to incorporate the teachings of Maloney with the motivation to identify the objects.

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Applicant has amended the claims to recite retrieving said optically encoded and/or electronically stored information. It is noted that Headrick does teach such step of retrieving.

Note rejection above.

Remarks

9. Applicants asserted that the combination of Headricks et al and Herz et al do not teach the claimed invention.. To supported their assertion, applicants argue that the combination of Headricks et al and Reilly et al do not teach retrieving such information from these tags, and the retrieving of such information from these tags such that an object profile contained in or identified by the information may be used to modify a unique profile of the person having the physical objects. In response, the examiner respectfully disagrees with applicants' arguments because Headricks et al does disclose the step of retrieving of the user's information (col. 9 line 54 through col. 10 line 13), and Hertz does disclose the concept of modifying a user's profile. (col. 18 lines 34-55). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the disclosures of Headrick to include the teachings of Hertz with the motivation to automatically determine the profile of the user.

In addition, Fables U.S. Patent No. 6,895,406, discloses the concept of updating "modifying" the user's personal profile with keywords used in the search phrase that returned the object selected by the user (col. 14 line 48 through col. 15 line 13)

In response to applicant's argument that Maloney is nonanalogous art o the combination of Headrick and Herz et al, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which

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the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Furthermore, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ... for objects already in the user's possession) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. **Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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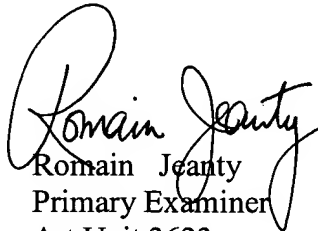
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RJ

11/18, 2005


Romain Jeanty
Primary Examiner
Art Unit 3623